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#### REMARKS

This Amendment is submitted in response to the Office Action mailed on January 26, 2006. Claims 1 - 20 are pending, and all stand rejected at present.

Recitations of claims 7 and 9 have been added to parent claims 1 and 8. Claims 7, 9, and 11 - 20 have been cancelled. Claims 21 - 26 have been added. No fee is due.

#### RESPONSE TO REJECTION OF CLAIMS 1, 2, AND 4

##### Point 1

Amended claim 1 recites

- 1) downloading of computer programs from the terminal to the in-car device and
- 2) that the programs generate a user interface.

Support for this is found in the Specification, page 7, second paragraph.

Applicant cannot locate such downloading in the applied references. MPEP § 2143.03 states:

To establish prima facie obviousness . . .  
**all the claim limitations** must be taught or  
suggested by the prior art.

Therefore, Applicant submits that the rejection of claim 1 cannot stand.

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## Point 2

The Office Action, page 3, bottom, states that Treyz fails to show

- locating the vehicle adjacent  
the terminal,
- identifying the user, and
- retrieving cash from the  
terminal.

Swaine is cited to show these elements.

However, the references are contradictory, and cannot be combined. Swaine shows a remote control 66 which is tethered to an ATM 42 by an armored cable 68. The cable 68 prevents thieves from stealing the remote control. (Column 3, top.)

Treyz shows a personal computer within a vehicle, which can communicate wirelessly with outside terminals. (Column 47.)

Therefore, the references are contradictory in at least the following respects.

- One, Swaine shows a physical connection between the remote control 66 and the ATM, while Treyz shows none.
- Two, the personal computer (ie, a remote control) in Treyz is removable from the ATM, while Swaine teaches that the remote control

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66 should not be removed from the ATM.

Contradictory references cannot be combined.

### Point 3

No teaching has been given for combining the references.  
The Office Action has only set forth elements supposedly found in the two references, and then concludes that it is obvious to add the elements of Swaine to Treyz.

But no explanation of **why** this addition is obvious has been given.

MPEP § 706.02(j) states:

#### Contents of a 35 U.S.C. 103 Rejection

. . . After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

. . .

(D) an **explanation** why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

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. . .

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

The "explanation," "suggestion," and "motivation" required by this MPEP section have not been set forth by the Office Action.

#### Point 4

No expectation of success has been shown, indicating that the combination of references actually works.

MPEP § 706.02(j) states:

#### Contents of a 35 U.S.C. 103 Rejection

. . .

To establish a prima facie case of obviousness, three basic criteria must be met.

. . .

Second, there must be a reasonable expectation of success.

. . .

The . . . reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

As explained above, Treyz operates wirelessly, while Swaine

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requires a cable. No explanation has been given as to how the wireless-reference is combined with the cable-reference.

Further, if wireless-operation is substituted for cable-operation (or vice-versa), then cable-operation (or wireless-operation) is eliminated. That renders one of the references unusable. MPEP § 2143.01 prohibits this:

THE PROPOSED MODIFICATION CANNOT RENDER THE  
PRIOR ART UNSATISFACTORY FOR ITS INTENDED  
PURPOSE.

THE PROPOSED MODIFICATION CANNOT CHANGE THE  
PRINCIPLE OF OPERATION OF A REFERENCE.

The preceding applies to claims 2 and 4.

#### **RESPONSE TO REJECTION OF CLAIM 7**

Claim 7 has been cancelled.

#### **RESPONSE TO REJECTION OF CLAIMS 3 AND 8 - 20**

##### **Claim 8**

The discussion of claim 1, above, applies to claim 3, and to claim 8 and its dependents. Claims 11 - 20 have been cancelled.

#### **RESPONSE TO REJECTION OF CLAIMS 5 AND 6**

These claims are considered patentable, based on their parents.

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#### ADDED CLAIMS

Support for the added claims is found in the Specification on page 3, lines 4 - 10; page 4, lines 7 - 14; Figure 2; the original claims; and other locations.

Added claim 21 states that identification data is entered into a wireless device which is maintained in a vehicle. The applied references do not show that.

-- Swaine may show entry of PIN into the remote control 66. (Column 4, line 33.)

However, Swaine's remote control 66 is not wireless, nor is it maintained in a vehicle.

-- Treyz may show a wireless device.

However, no PIN is entered into that device.

The preceding applies to claim 24.

Added claim 21 states that programs are transferred to the device, which generate an interface. Applicant cannot locate such an operation in either reference.

Added claim 23 states that a card is presented to the wireless device. Swaine is contrary, in stating that a card is presented to the card reader 48 of the ATM, not to his remote control. (Column 4, lines 16 - 20.) Applicant cannot locate a statement in Treyz stating that a card is presented to his wireless computer.

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Added claim 25 states that

- the wireless device within the vehicle includes a card reader and a keypad,
- a card is inserted into the card reader, and
- a PIN is entered into the keypad.

In Swaine, as explained above, the card is inserted into the ATM, not Swaine's remote control 66. Further, Swaine's remote control 66 is not wireless.

In Treyz, Applicant cannot see that a PIN is entered into the wireless computer.

Added claim 26 states that programs are transferred to the device, which generate an interface. Applicant cannot find that in the applied references.


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**CONCLUSION**

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,

  
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April 26, 2006  
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